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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q61244

Taizo AKIMOTO

Appln. No.: 09/749,752

Group Art Unit: 1634

Confirmation No.: 4934

Examiner: Jeanine A. Goldberg

Filed: December 28, 2000

For: TEST PIECE, ANALYSIS METHOD USING THE TEST PIECE, AND ANALYSIS
SYSTEM USED FOR THE METHOD

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated February 3, 2005. Entry of this
Reply Brief is respectfully requested.

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STATUS OF CLAIMS

The status of the claims remains unchanged as set forth in Appeal Brief, filed November 23, 2004.

Claims 1-6, 9, and 12-17 are canceled.

Claims 7, 8, 10, 11 and 18-21 are rejected.

The rejections of claims 7, 8, 10, 11, and 18-21 are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Zeleny et al. (US 6,215,894; hereafter “Zeleny”).

Claims 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Noblett (US 6,362,004).

Claims 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Perttunen et al. (US 5,968,728; hereafter “Perttunen”).

ARGUMENT

In the Appeal Brief filed November 23, 2004, Appellant argued that Zeleny and Perttunen do not teach or suggest the feature of claim 8 of a means for attaching management information ... using a marker the same as or similar to the marker used for marking the target substance. The Examiner has not accorded any patentable weight to the functional limitation of using a marker the same as or similar to the marker used for marking the target substance. In the Examiner's Answer, the Examiner states the following:

The recitation in instant Claim 8 states that the management information is printed on the test piece using a marker the same as or similar to the marker used for marking the target substance. The claims are drawn to an analysis system, i.e. a product. Therefore, the elements of the system include a means for attaching management information to the test piece, i.e. a spotter; a means for obtaining information concerning the positions of the probes to which the target substance has bound and simultaneously detecting the management information attached to the test piece, i.e. a photomultiplier (PMT); and a means for storing the management information, i.e. a computer. The computer has several file folders as means for storing information. The instant claim does not require any management information, any target or any substrate. The instant claim does not require any particular method steps because the claim is directed to a product. Therefore, the recitation does not impart any additional limitations on the instant claims.

Pages 5-6 of Examiner's Answer.^{FN}

The Examiner further states:

The specification clearly teaches a spotting device is a means for attaching management information peculiar to the test piece to a predetermined location on the test piece. The recitation "using a marker the same as or similar

^{FN} Appellant notes the explicit examples pointed out for various means elements in the Examiner's Answer should not necessarily limit the claims.

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to the marker used for marking the target substance" does not change the structure provided by the specification would have such a function.

The response asserts that instant independent claims 8, 11, 20 and 21 explicitly recite the marker. This argument has been thoroughly reviewed, but is not found persuasive because the instant claims, Claim 8, for example provides three elements: (a) means for attaching management information, (b) means for obtaining information and (c) means for storing the management information. While the claims discuss that the means for attaching management information peculiar to the test piece to a predetermined location on the test piece using a marker the same as or similar to the marker used for marking the target substance, this recitation is direct to the function of the means for attaching. The claim does not require the markers in the product claimed.

Page 9 of Examiner's Answer.

Appellant respectfully disagrees with the Examiner's position. In particular, Appellant submits that "using a marker the same as or similar to the marker used for marking the target substance" does have patentable weight. The Examiner appears to be asserting that the claims of the present application merely recite a number of means limitations. However, the claims actually recite certain means-plus-function limitations, and the functions recited in the means-plus-function limitations are entitled to patentable weight. See *In re Mott*, 557 F.2d 266 (CCPA 1977).

In the *In re Mott* case, the U.S. Court of Customs and Patent Appeals (CCPA) reversed a decision of the U.S. Patent and Trademark Office Board of Patent Appeals affirming the rejection by the patent examiner of the inventor's application for a drilling tool. The CCPA held that the claims of the application did not merely recite a means, but recited a means plus a function not found in the existing patent, and thus the claims were not anticipated by the patent. See *Id.*, 557 F.2d at 269. The single central issue in *In re Mott* is whether the means defined in the final clause of claim 28 of Mott's application is found in the applied reference (Leutwyler).

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See *Id.*, 557 F.2d at 268. The final clause of claim 28 reads as follows: “means for spacing said ball type valve member from said seat prior to commencing to effect rotation of said ball-type valve member to the open position to equalize the fluid pressure in said bore about said ball-type valve member.” *Id.* The appellant’s conceded that “appellant and Leutwyler achieve the same ultimate result, namely, equalization of the pressure on either side of the ball before it is rotated. Appellant, however, contends that Leutwyler does it with a bypass valve mechanism whereas he does it by spacing his ball valve from its seat, hence the significance of the claim language ‘means for spacing said ball type valve member from said seat * * * to equalize the fluid pressure in said bore about said ball-type valve member.’” *Id.* at 269. The CCPA stated: “The statement of the function of equalizing the fluid pressure is an important part of the means-plus-function limitation; it qualifies the function of spacing.” *Id.* The CCPA concluded that the claims do not “‘merely recite a ‘means’.” They recite a means plus a function which is not to be found in Leutwyler. They therefore do not read on that reference and are not anticipated thereby.’ *Id.*

Likewise, the claims of the present application do not merely recite means limitations, but recite means-plus-function limitations, and the functions recited in the appealed claims have patentable weight. Moreover, as argued in the Appeal Brief, the prior art fails to teach or suggest these functional limitations. The Examiner has not rebutted these arguments. Rather, the Examiner has asserted that the functional limitations of the appealed claims do not have patentable weight. However, as described above in relation to the *In re Mott* case, the functional limitations of Appellant’s claims do have patentable weight. Appellant submits that the basic

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error of the Examiner's rejection is that the Examiner truncates much of the functional aspects out of the claim element, essentially ignoring an explicit recitation. To the extent that the Examiner contends that the structure of the means would not change, Applicant notes that the functional language at issue would affect the structure relative to a source of the marker. Therefore, the Examiner's contention is incorrect. As argued in the Appeal Brief, Zeleny and Perttunen do not teach or suggest these limitations. Therefore, Appellant submits that claim 8 is not anticipated by Zeleny or Perttunen.

Appellant submits that claims 7, 18 and 19 are not anticipated by Zeleny or Perttunen, at least because of their dependence from claim 8.

Also, claims 10, 11, 20 and 21 are not anticipated by Zeleny or Perttunen for reasons analogous to those for claim 8.

In the Appeal Brief, Appellant argued that Zeleny, Perttunen and Noblett do not teach or suggest the means for obtaining information concerning the positions of the probes to which the target substance has bound and simultaneously detecting the management information attached to the test piece, as recited in claim 8 of the present application. See page 12 of Appeal Brief. In response to this argument, the Examiner now asserts that Zeleny can be interpreted to disclose one complex step in which scanning of information, opening a file folder and scanning the microarray image are all part of the one step. See page 12 of Examiner's Answer. The Examiner asserts that this interpretation is a reasonable one, but Appellant disagrees.

Zeleny discloses that the bio chip passes to a scanner 42, which first scans the barcodes 16b and 18b. The system 34 responds by opening file folders 36 that are logically linked to the

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identifiers. In other words, the barcodes are scanned first, to open a scan protocol and upon completion of the scan protocol, an image map becomes stored. Thus, Zeleny clearly discloses that scanning of the barcodes is not performed simultaneously with the opening of the file folders. See Zeleny at col. 3, lines 30-40 and FIG. 4. Moreover, even if one considers the method of Zeleny to be one complex step, rather than multiple steps, the different portions of the one complex step are not being performed simultaneously.

The Examiner refers to the Appellant's specification (page 9, lines 10-15) which states:

the ID information and the information concerning the positions of the probes to which the target substance has bound may be detected simultaneously requiring no additional step, i.e., the step of detecting the ID information may be incorporated into the step of obtaining the information concerning the positions of the probes to which the target substance has bound

and tries to alter the meaning of the term "simultaneously" recited in the appealed claims.

Specifically, the Examiner seems to be asserting that "simultaneously" means "requiring no additional step." Appellant submits that the Examiner's modification of the plain meaning of the term "simultaneously" is misplaced. Although the performing of two operations simultaneously would logically mean that no additional steps are required to perform those two operations, it does not necessarily follow that combining multiple steps into one complex step would mean that the combined multiple steps would be performed simultaneously. The combined multiple steps could be performed in a sequence in a single complex step. Appellant submits that the term "simultaneously" recited in the appealed claims should maintain its plain meaning, since the meaning of the term "simultaneously" is known to one of ordinary skill in the art. Thus, there is no reason to look to the specification to determine the meaning of "simultaneously."

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Based on the plain meaning of the term "simultaneously" and the foregoing discussion, the appealed claims 7, 8, 10, 11 and 18-21 are not anticipated by Zeleny, Noblett or Perttunen for the reasons described in the Appeal Brief. See pages 12-14 of the Appeal Brief.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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